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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,200	08/22/2001	Roger C. Palmer	077056-0353	8757

7590 09/16/2004
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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 09/16/2004 11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,200

Applicant(s)

PALMER ET AL.

Examiner

HENRY N TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-17, 19 and 22-26 is/are rejected.
- 7) ☒ Claim(s) 7, 18, 20, 21 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office action is in response to the applicants' Reply received 8/14/03 (Paper No.9), and the Supplemental information disclosure statement (IDS) received 11/21/03 (Paper No. 10). The papers have been entered. Applicants' remarks have been fully considered, with the results set forth as follows.

Information Disclosure Statement

1. The examiner has considered the references listed in form PTO/SB/08a/b attached to the IDS received 11/21/03 (see the attached form PTO/SB/08a/b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 stand rejected under 35 U.S.C. 102(e) as being anticipated by Fenton et al (U.S. Patent No. 6,343,264) as recited in paragraph 2 of the prior Office action mailed 4/14/03 (Paper No. 7).
4. Claims 8-15 stand rejected under 35 U.S.C. 102(e) as being anticipated by Ringland et al (U.S. Patent No. 6,122,391) as recited in paragraph 3 of the above-identified prior Office action.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 16, 17, 19 and 22-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al (U.S. Patent No. 6,343,264) in view of by Ring et al (U.S. Patent No. 5,754,184) as recited in paragraph 5 of the above-identified prior Office action.

Allowable Subject Matter

7. Claims 7, 18, 20, 21 and 27 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as recited in paragraphs 6 and 7 of the above-identified prior Office action.

Response to Arguments

8. Applicants' arguments/remarks have been fully considered but they are not persuasive. Applicants argue that applicants' claimed invention is directed to method and apparatus for applying a chosen decorative element to a window covering at a retail location; wherein, applying the decorative element to the window covering does means physically embodying the data representing the decorative element on the window covering using printing, laminating or texturing techniques; whereas, the prior art, Fenton and Ringland, neither teaches or suggest

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actually physically applying a chosen decorative element to a window covering at a retail location; also, another prior art, the Ring's invention fails to teach or suggest the step of applying the decorative element to the window covering at the retail outlet. Examiner disagrees because of the following reasons: (i) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "actually physically applying a chosen decorative element to a window covering ...using printing, laminating, or texturing techniques") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993); (ii) Fenton clearly teaches that the decorative element is, e.g., one of a color selected from a database, and then apply to the window covering using a computer 13 having a display monitor 16 located at the retail store, see the references recited in paragraph 2 of the prior Office action; also, col. 2, lines 26-40; (iii) It is proper to use the specification to interpret what the applicants meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claims. As specifically pointed out in the specification: "window covering", "in-store", and "decorative element" are not terms of limitations, see specification, Paragraph 38; and (iv) the Ring's printer coupled the computer, see figs. 1 and 7, is relied for the claimed "a printer" recited in the base claim 16 so that claim 16 is rendered obvious over Fenton in view of Ring as recited in paragraph 5 of the above-identified prior Office action. Claims 1-6, 8-17, 19 and 22-26 are therefore stand rejected as recited in the previous Office action.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N TRAN whose telephone number is 703-308-8410. The examiner can normally be reached on M-F 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A HJERPE can be reached on 703-305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/15/04

Henry N. Tran

**HENRY N. TRAN
PRIMARY EXAMINER**